

Notice of Allowability

Application No.

09/853,731

Examiner

Chih-Min Kam

Applicant(s)

PAPADIMITRIOU, APOLLON

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6/26/06.
2. ☒ The allowed claim(s) is/are 24,25,27-34,38-42,51-55,59-61,67,68,71-77 and 83-108.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 8/18/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Status of the Claims

1. Claims 24, 25, 27-34, 38-42, 51-55, 59-61, 67, 68, 71-77 and 83-108 are pending.

Applicants' amendment, Declarations of Pascal Sebastian Bailon and Apollon Papadimitriou and Exhibits A-C filed on June 26, 2006 are acknowledged. Applicants' response and the Declarations have been fully considered. Claims 60, 61, 84, 107 and 108 have been amended. Thus, claims 24, 25, 27-34, 38-42, 51-55, 59-61, 67, 68, 71-77 and 83-108 are examined.

Withdrawn Claim Rejections-35 USC § 112

2. The previous rejection of claims 60, 61, 84 107 and 108 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment to the claim, and applicant's response at page 14 of the amendment filed on June 26, 2006.

Withdrawn Claim Rejections-35 USC § 102

3. The previous rejection of claims 67-68, 71, 73, 75, 77, 83, 85, 86, 91-101, 104 and 106 under 35 U.S.C. 102(e) as being anticipated by Bailon (U.S. Patent 6,583,272), is withdrawn in view of Declarations of Pascal Sebastian Bailon and Apollon Papadimitriou, Exhibits A-C, and applicant's response at pages 14-16 of the amendment filed on June 26, 2006.

Withdrawn Claim Rejections-35 USC § 103

4. The previous rejection of claims 72, 74, 76, 84, 87-89, 102, 103, 105, 107 and 108 under 35 U.S.C. 103(a) as being unpatentable over Bailon (U.S. Patent No. 6,583,272) in view of Sato (WO 00/51629), is withdrawn in view of Declarations of Pascal Sebastian Bailon and Apollon

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Papadimitriou, Exhibits A-C, and applicant's response at pages 16-17 of the amendment filed on June 26, 2006.

Examiner's Amendment

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Amendments to the Specification:

Please add the following paragraph after the title "ERYTHROPOIETIN COMPOSITION" at page 1 of the specification:

This application claims priority of European Patent Office Application No. 00110355.5, filed May 15, 2000.

The following is an **Examiner's Statement of Reasons for Allowance**: The following reference appears to be the closest art to the claimed invention. Bailon (U. S. Patent 6,583,272) teach pegylated erythropoietin (peg-EPO) in various formulations such as the formulation containing 10 mM sodium phosphate, 140 mM sodium sulfate, pH 6.2 (Example 8, Table 3), which has the priority date of June 27, 2000, since the four provisional applications of the patent do not disclose the formulations, while the priority document of the instant application, EP 00110355.5 filed May 15, 2000, discloses the formulation of peg-EPO. Thus, the U. S. Patent 6,583,272 is not 102(e) reference to the instant application, although a terminal disclaimer has been filed. Therefore, the claims are allowable over the art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Primary Patent Examiner



primary

**CHIH-MIN KAM
PATENT EXAMINER**

CMK

September 13, 2006